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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,342	01/26/2001	Mark G. Fleischhacker	LRM-33657	6291
56080	7590	03/29/2007	EXAMINER	
WHYTE HIRSCHBOECK DUKEK S.C. ONE EAST MAIN STREET SUITE 300 MADISON, WI 53703-3300			FOREMAN, JONATHAN M	
ART UNIT		PAPER NUMBER		3736
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/29/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/770,342	FLEISCHHACKER, MARK G.
	Examiner Jonathan ML Foreman	Art Unit 3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 April 2006 and 10 January 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 and 25-29 is/are pending in the application.
  - 4a) Of the above claim(s) 3,5,10-21 and 25-29 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4 and 6-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Embodiment I in the reply filed on 1/10/07 is acknowledged. The traversal is not found persuasive because where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. See MPEP 806.04(f) [R-3]. The present application includes claims directed to two or more mutually exclusive species. The requirement is deemed proper and made Final.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4 and 6 – 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,251,640 to Osborne.

In regard to claims 1, 2, 4 and 6 – 9, Osborne discloses a guide wire consisting essentially of a core wire (20) having a distal, medial and proximal segments, the core wire substantially comprising a non-metallic, non-braided, non woven material (Col. 3, lines 18 – 21; Col. 4, lines 8 –

11). The distal segment has a diameter which is less than that of the core wire medial and proximal segments (Figure 2). The core wire has a polymeric coating thereon which covers substantially the entire length of the core wire (Col. 5, lines 7 – 10). The core wire includes a taper (Figure 2). The core wire comprises a polymeric material and is covered completely with a second polymeric material (Col. 4, lines 8 – 11; Col. 5, lines 7 – 10).

4. Claims 1, 2, 4 and 6 – 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,944,701 to Dubrul.

In regard to claims 1, 2, 4 and 6 – 9, Dubrul discloses a guide wire consisting essentially of a core wire (Figure 1) having a distal, medial and proximal segments, the core wire substantially comprising a non-metallic, non-braided, non woven material (Col. 3, lines 45 – 46). The distal segment has a diameter which is less than that of the core wire medial and proximal segments (Col. 3, lines 16 – 17). The core wire has a polymeric coating thereon which covers substantially the entire length of the core wire (Col. 3, lines 28 – 31). The core wire includes a taper (Col. 3, lines 16 – 17). The core wire comprises a polymeric material and is covered completely with a second polymeric material (Col. 3, lines 45 – 46; Col. 3, lines 28 – 31).

5. Claims 1, 2, 4 and 6 – 9 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,354,989 to Nudeshima.

In regard to claims 1, 2, 4 and 6 – 9, Nudeshima discloses a guide wire consisting essentially of a core wire (2a) having a distal, medial and proximal segments, the core wire substantially comprising a non-metallic, non-braided, non woven material (Col. 3, lines 60 – 61). The distal segment has a diameter which is less than that of the core wire medial and proximal segments (Col. 4, lines 10 – 12). The core wire has a polymeric coating (7) thereon which covers substantially the entire length of the core wire. The core wire includes a taper (Col. 4, lines 10 – 12). The core wire

comprises a polymeric material and is covered completely with a second polymeric material ((Col. 3, lines 60 – 61; Col. 4, lines 32 – 41).

*Response to Amendment*

6. The Declaration of William Whealon under 37 CFR 1.132 filed 4/4/06 is sufficient to overcome the rejection of claims 1, 2, 4 and 6 – 9 based upon Hurtak et al. ('016).

*Response to Arguments*

7. Applicant's arguments filed 4/4/06 have been fully considered but they are not persuasive. Applicant asserts that because claim 1 has been amended to recite "consisting essentially of" rather than "comprising" that the anticipation of Osborne has been overcome. However, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See MPEP 2111.03. Furthermore, the majority of the core ("substantially comprising") as disclosed by Osburne is made up of a non-metallic, non-braided, non woven material.

*Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMLF

  
MAX HINDEBURG  
PATENT EXAMINER  
USPTO